

**Remarks/Arguments:**

This is in response to the final rejection dated April 14.

Applicant requests the issuance of a Notice of Allowance, since the examiner has failed to establish a *prima facie* case of obviousness in the present matter. The reasons for this conclusion are set out below.

In the final rejection, the only issue at stake was obviousness under 35 U.S.C. 103. With respect to main claim 37, which is related to an ink-jet printing ink composition, the examiner acknowledged on page 3 of the Office Action that the primary reference Siddiqui does not disclose a very important component of the claimed composition, i.e. the specific matting compound. According to the claim, that matting compound must be present in a specific amount of 1.8 weight percent of the overall composition, it must have a higher boiling point than the fast drying solvent, and the binder must be insoluble in the matting compound. For this purpose, the binder is selected from a narrow group of components.

In order to overcome the deficiency of Siddiqui – which contains no disclosure or suggestion with respect to such a matting compound, the examiner combined Siddiqui with Houle.

However, combining those two references would not have resulted in a teaching of all elements of claim 37, since neither Siddiqui nor Houle teach the specific binder components according to claim 37. In order to overcome this deficiency, the examiner further combined Siddiqui and Houle with Subbaraman.

Applicant would have expected a more detailed explanation why a skilled person should have combined three different prior art references with each other.

Unfortunately, the decisive passage on page 4 of the Office Action exhausts itself in the statement that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink set taught by Siddiqui with the ink taught by Subbaraman et al. in order to provide a stable ink with improved properties of opacity, adhesion, and machine compatibility.

The argument of the examiner does not meet the established criteria of a *prima facie* case of obviousness:

- a) The examiner has not considered the actual problem to be solved

First of all, the examiner has underpinned her findings with a problem that is not supported by the actual content of the present application. The problem addressed by the present invention was not to provide a stable ink with improved properties of opacity, adhesion, and machine compatibility. Rather, as clearly stated at page 3, first paragraph, of the original specification, there was a need for improving the formulation of invisible marking ink-jet inks, in order to make the printings as covert as possible by matching the gloss of the ink-jet printing to the substrate's own gloss.

By not taking into consideration the actual problem to be solved by the present invention, the examiner has arrived at an erroneous finding of *prima facie* obviousness.

As mentioned above, the actual problem of the present invention as formulated above has been surprisingly solved by the finding that suitable ink-jet ink compositions may be provided if specific binder components are used in combination with specific matting agents. This combination of binder and matting agents has to fulfill several criteria.

To this point, the examiner has not been able to identify passages in the prior art containing a teaching, suggestion or motivation for a skilled person that ink-jet ink compositions comprising the specific binder components and the specific matting agent components of the current claim 37 would actually solve the problem underlying the present invention.

b) The MPEP criteria for a prima facie case of obviousness have not been met

In the MPEP's section 2143 concerning obviousness, criteria for establishing a prima facie case of obviousness are clearly set out. In the absence of a statement by the examiner, it is not clear to the applicant to which of the various criteria the examiner has referred in the present case when allegedly establishing a prima facie case of obviousness. Therefore, applicant briefly discusses the three alternatives which appear to have the most relevance for the present case:

According to requirement A of MPEP section 2143, a prima facie case of obviousness is established if prior art elements can be combined with each other according to known methods to yield predictable results. Applicant respectfully submits that the conditions for such a finding are not given here: As has been mentioned above, nowhere in the cited prior art references is the slightest hint to be found that the matting agent compounds specified in the composition of claim 37 actually function as matting agent compounds. In Houle, the only reference the examiner has cited with respect to such compounds, those components are described as solvents, not as matting agents. Therefore, in the prior art there is no teaching that such compounds would actually show the matting effect desired by the present invention. Under these circumstances, applicant respectfully submits that the resulting matting effect was unpredictable. It may also be submitted that the desired matting effect only occurs in combination with the binder components of claim 37. Therefore, the requirement that

each element known from the prior art also in accordance with the present invention must show the function it possesses in isolation, is not fulfilled here.

Applicant also respectfully submits that a finding of a *prima facie* case of obviousness cannot be based on requirement B of MPEP section 2143, that the present invention would be a simple substitution of one known element for another to obtain predictable results.

The present invention is not about a substitution of a known element by another known element. As the examiner admitted in the Office Action, Siddiqui does not teach such a matting agent. Thus, this is not a case of substituting one component in Siddiqui's ink with another one; rather, the matting agent has to be added.

The function of the matting compounds was not known or derivable from the prior art. Therefore, the results obtained with the composition of claim 37 were not predictable.

Finally, and maybe most importantly, requirement G according to MPEP section 2143 is not applicable here: there is no teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claim invention. Applicant respectfully submits that this requirement is still good law under the KSR/Teleflex decision of the Supreme Court. In that decision, the Supreme Court raised clear concerns against simply combining references from the prior art with each other.

In their decision, the Supreme Court stated that the mere fact that references can be combined or modified does not render the results in combination obvious unless the results would have been predictable to one of ordinary skill in the art. Applicant respectfully submits that these conditions are not met here. While it is correct that the three prior art references to which the examiner has referred all are concerned with

ink-jet ink compositions, it has nevertheless to be made clear that all those references are absolutely silent with respect to the problem underlying the present invention, and that the inks disclosed therein are structurally significantly different from each other.

Applicant respectfully submits that the examiner's statement that the skilled person would have readily combined Siddiqui, Houle and Subbaraman with each other does not provide any explanation why the skilled person should have done so: none or the references teaches or suggests only remotely a matting effect of a matting compound. None of the references teaches or suggests a combination of the specific binder materials with the specific matting agents of claim 37, taking into consideration the necessary selection criteria of boiling point and solubility of the components.

Of course, the skilled person *could* have combined the teachings of the three references with each other, had he simply ignored the significant differences between the inks of e. g. Siddiqui and Houle. As has been noted several times before, Houle's composition does not comprise any binder component at all. Why should a skilled person have combined such significantly different inks as taught in Siddiqui and Houle with each other? No explanation has been given to that question. Moreover, and quite importantly according to the KSR/Teleflex decision, it is not apparent why the result obtained with a composition of claim 37 would have been predictable to a skilled person. In the absence of any statement or suggestion in the prior art to the desired matting effect, it is not apparent to the applicant where the skilled person would have derived such a predictability.

In consequence, there was also no reasonable expectation of success for a skilled person: the prior art did not provide him with the slightest pointer that the desired adaptation of gloss between the imprint and the underlying substrate could be achieved with an ink composition according to claim 37.

In summary, applicant respectfully rejects the proposition that there was an incentive for the skilled person to modify the teaching of siddiqui in order to arrive at the subject matter of claim 37. As has been reiterated by the Supreme Court in KSR/Teleflex, a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references. Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Such reasoning has not been provided.

As a final remark, applicant would like to note that the question to be decided here is whether claim 37 in its entirety is rendered obvious by the prior art. For that purpose, all claim limitations must be considered, in particular the specific selection of binder component and matting agent according to claim 37. In order to arrive at all elements of claim 37, the examiner had to pick features out of three references, without providing a sufficient reasoning why the skilled person would have picked exactly those features from clearly different ink compositions.

In summary, applicant respectfully submits that the claims of this application should be allowed, since no *prima facie* case of obviousness has been established.

Respectfully submitted,

/Charles Fallow/

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